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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/700,278

11/03/2003

David J. Carini

PH-7426 NP

4516

23914 7590 05/25/2007  
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EXAMINER
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BALASUBRAMANIAN, VENKATARAMAN

ART UNIT	PAPER NUMBER
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1624

MAIL DATE	DELIVERY MODE
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05/25/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/700,278

Applicant(s)

CARINI, DAVID J.

Examiner

Venkataraman Balasubramanian

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

Applicants' response, which included cancellation of claim 12, filed on 2/14/2007, is made of record. Claims 1-11 and 13-16 are now pending. In view of applicants' response rejection of claim 12 made in the previous office action has been rendered moot. However, the following 103 rejection made in the previous office action is maintained.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-11 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Getman et al., US 6,143,788 for reasons of record. To repeat:

Getman et al. teaches several bisaminoacid hydroxyethylaminosufonamides compounds as retroviral protease inhibitors for treating HIV infection, which include instant compounds. See column 2, formula 1 and note the definition of various variable groups  $R^1$ ,  $R^2$ ,  $R^3$ ,  $R^4$ ,  $R^{10}$ ,  $R^{11}$ ,  $R^{12}$  and  $R^{13}$ . Especially note when  $R^{12}$  is H,  $R^{13}$  is aralkyl or heteroarylalkyl, compounds taught by Getman et al. includes instant compounds. Also note the  $R^{12}$  and  $R^{13}$  choices include isopropyl and various aralkyl and heteroarylalkyl as shown in column 6. See column 6 through 102 for various preferred embodiments, schemes for making and examples of compounds made. See also Table 2-16 shown in column 102-286. Especially see Table 3B, 3D, 3F, 3H, 4B, 4D, 4F, 4H, 5B, 5D, 5F, 5H, 6B, 6D, 6F, 6H, 7B, 7D, 7F and 7H for various aralkyl and heteroarylalkyl compounds as required by the instant claims.

Instant claims require a two methyl groups on the carbon attached to  $R^1$ . Getman et al. differs from the instant claims in exemplifying such compounds.

However, Getman et al. teaches equivalency of those compounds taught in the Tables 2-16(column 102-286) with those generically recited in pages 2-6.

Thus it would have been obvious to one having ordinary skill in the art at the time of the invention was made to make compounds using the teachings of Getman et al.,

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including the carbon bearing the aryl groups or heteroaryl groups to have two methyl groups as required by the instant claims and expect resulting compounds to possess the uses taught by the art in view of the equivalency teaching outline above.

This rejection is same as made in the previous office action but now excludes cancelled claim 12. Applicants' argument to overcome this rejection is not persuasive. As noted above, Getman et al., teaches in Table 3B, 3D, 3F, 3H, 4B, 4D, 4F, 4H, 5B, 5D, 5F, 5H, 6B, 6D, 6F, 6H, 7B, 7D, 7F and 7H for various aralkyl and heteroarylalkyl compounds as required by the instant claims. These compound differ only in not have a gem dialkyl groups on the alkyl of araalkyl and heteroarylalkyl. Given the teachings of large number of compounds and the generic teaching of such groups, it would be obvious to one trained in the art to modify these groups and arrive at gem dialkyl groups on the araalkyl and heteroarylalkyl.

Hence, this rejection is proper and is maintained.

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (571) 272-0662. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is James O. Wilson, whose telephone number is 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned (571) 273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAG. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).

  
Venkataraman Balasubramanian

5/23/2007